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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/084,032	02/27/2002	Daniel R. Drake	RSW920010197US1	8073

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EXAMINER

MITCHELL, JASON D

ART UNIT	PAPER NUMBER
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2124

DATE MAILED: 02/23/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/084,032	Applicant(s) DRAKE ET AL.	
	Examiner Jason Mitchell	Art Unit 2124	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 February 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>2/27/02</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is in response to an application filed on 2/27/02.
2. Claims 1-28 are pending in this case.

Claim Objections

3. **Claim 11 is objected to because it is improperly dependent on claim 19.** It should be kept in mind that a dependent claim may refer to any preceding independent claim. See MPEP § 608.01(n). For the purposes of this examination claim 11 will be assumed to depend from claim 1.

Claim Rejections - 35 USC § 101

4. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 21-23 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. The similarity between the language of independent claims 21 and 24 raises questions to the statutory nature of claims 21-23. In order to be considered statutory the means recited in claims 21-23 would necessarily consist of computer-readable program code, embodied on a computer readable media. This would result in a substantial duplication of claim 26 requiring an objection under 37 USC 1.75. Accordingly, for the purposes of this examination, it must be assumed that claims 21-23 do not incorporate computer-readable program code embodied on a computer readable media and hence that the claims recite only an abstract idea, without

reciting any practical application in the technological arts and are therefore directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. **Claims 1-7, 11-16 and 19-28 are rejected under 35 U.S.C. 102(b) as being anticipated by US 5,761,380 to Lewis et al. (Lewis).**

Regarding Claim 1: Lewis discloses a method of improving installation of software packages, comprising steps of: assigning a weight to each of one or more selected values of one or more installation parameters associated with a software product installation (col. 6, lines 15-16 'weighted algorithm'); determining a plurality of potential target systems on which the software product installation might be performed (col. 6, lines 55-59 'changing the installation from three machines to two machines'); identifying a routine to analyze each of the installation parameters (col. 5, lines 43-44 'performance calculations'); programmatically interrogating each of the potential target systems for its status of each of the installation parameters, using the identified routines (col. 5, lines 45-48 'The planning tool senses the hardware capacity'); and using the assigned weights, in combination with the selected values and the status of each of the installation parameters (col. 6, lines 15-16 'weighted algorithm'), to compute a suitability

assessment for each of the potential target systems (col. 6, lines 36-39 'the planning tool may indicate that performance would be "not acceptable"').

Regarding Claim 2: The rejection of claim 1 is incorporated; further, Lewis discloses invoking the identified routines at each of the potential target systems (col. 7, lines 1-2 'sense the capabilities on other machines').

Regarding Claim 3: The rejection of claim 1 is incorporated; further, Lewis discloses comparing the status of each of the installation parameters to the selected values to determine the associated weight to be used for this installation parameter for this potential target system (col. 6, lines 15-16 'weighted algorithm'); and adding the determined weights to yield the computed suitability assessment for this potential target system (col. 6, lines 15-16 'weighted algorithm').

Regarding Claim 4: The rejection of claim 1 is incorporated; further, Lewis discloses ranking the potential target systems according to their suitability assessments (col. 6, lines 36-39 'the planning tool may indicate that performance would be "not acceptable"').

Regarding Claim 5: The rejection of claim 4 is incorporated; further, Lewis discloses providing the ranking to a software installer (col. 6, lines 34-36 'predicted performance ... are presented to the user').

Regarding Claim 6: The rejection of claim 5 is incorporated; further, Lewis discloses the software installer is a person and wherein the providing step comprises the step of displaying the ranking on a graphical user interface (col. 6, lines 34-36 'predicted performance ... are presented to the user').

Regarding Claim 7: The rejection of claim 5 is incorporated; further, Lewis discloses the software installer is a programmatic process (col. 10, lines 28-30 'The information sensed ... is used by the expert system to arrive at the best installation plan') and wherein the providing step further comprises the step of supplying the ranking to the programmatic process in a machine-readable form (col. 10, lines 28-30 'The information sensed ... is used by the expert system to arrive at the best installation plan').

Regarding Claim 11: The rejection of claim 1 is incorporated; further Lewis discloses the specifications are part of an installation object defined for the software product installation (col. 5, lines 32-34 'the planning tool is ... part of the software').

Regarding Claim 12: The rejection of claim 1 is incorporated; further Lewis discloses the step of transmitting a message to each of the potential target systems (col. 7, lines 1-2 'sense the capabilities on other machines'), wherein the message specifies the identified routines (col. 5, lines 54-56 'CPU speed is determined by executing an algorithm').

Regarding Claim 13: The rejection of claim 12 is incorporated; further Lewis discloses the message is to be processed by an installation agent residing on each of the potential target systems (col. 5, lines 37-40 'the planning tool could come as a standalone application').

Regarding Claim 14: The rejection of claim 12 is incorporated; further Lewis inherently discloses receiving the transmitted message at a particular one of the potential target systems; invoking the identified routines from the received message, thereby determining the status of each of the installation parameters for this particular potential

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target system; and returning the status of each of the installation parameters in a response message. When sensing the capabilities on other machines (col. 7, lines 1-2) it is necessary to send a message to that other machine and receive a response back after the appropriate routine has been executed (i.e. col. 5, lines 54-56 'CPU speed is determined by executing an algorithm').

Regarding Claim 15: The rejection of claim 5 is incorporated; further Lewis discloses using the provided ranking, by the software installer, to select one or more of the potential target systems as one or more actual target systems for the software product installation (col. 10, lines 28-30 'The information sensed ... is used by the expert system to arrive at the best installation plan').

Regarding Claim 16: The rejection of claim 15 is incorporated; further Lewis discloses distributing a software installation package for the software product installation to each of the selected actual target systems (col. 8, lines 19-21 'write to diskette the components to be installed'); and performing the software product installation on the selected actual target systems (col. 8, lines 22-24 'the installation diskette ... is used to install the components').

Regarding Claim 19: The rejection of claim 16 is incorporated; further Lewis discloses configuring the software installation package prior to operation of the distributing step (col. 8, lines 14-17 'The installation process would be told ... how to distribute the components').

Regarding Claim 20: The rejection of claim 19 is incorporated; further Lewis discloses the configuring step further comprises reflecting the status for at least one of the

installation parameters in the configured software installation package (col. 8, lines 14-17 'how to distribute the components across that number of machines').

Regarding Claims 21 and 24: Lewis discloses means for determining a plurality of potential target systems on which the software product installation might be performed (col. 6, lines 55-59 'changing the installation from three machines to two machines'); means for programmatically interrogating each of the potential target systems for its status of each of one or more installation parameters associated with a software product installation (col. 5, lines 43-44 'performance calculations'), by invoking, at each of the potential target systems, a routine which is identified for analyzing that installation parameter (col. 5, lines 54-56 'CPU speed is determined by executing an algorithm'); and means for using weights which are assigned to each of one or more selected values of the one or more installation parameters (col. 6, lines 15-16 'weighted algorithm'), in combination with the selected values and the status of each of the installation parameters, to compute a suitability assessment for each of the potential target systems (col. 6, lines 36-39 'the planning tool may indicate that performance would be "not acceptable"').

Regarding Claim 22 and 26: The rejections of claims 21 and 24 are incorporated; further, Lewis discloses means for ranking the potential target systems according to their suitability assessments (col. 6, lines 36-39 'the planning tool may indicate that performance would be "not acceptable"').

Regarding Claim 23: The rejection of claim 22 is incorporated; further, Lewis discloses means for providing the ranking to a software installer (col. 6, lines 34-36 'predicted performance ... are presented to the user').

Regarding Claim 25: The rejection of claim 24 is incorporated; further, Lewis discloses computer-readable program code means for comparing the status of each of the installation parameters to the selected values to determine the associated weight to be used for this installation parameter for this potential target system; and computer-readable program code means for adding the determined weights to yield the computed suitability assessment for this potential target system (col. 6, lines 15-16 'weighted algorithm').

Regarding Claim 27: The rejection of claim 24 is incorporated; further, Lewis discloses the potential target systems are remotely located (col. 2, lines 24-26 'installation of components of the network application can be remotely from the local machine').

Regarding Claim 28: Lewis discloses a method of improving installation of software packages, comprising steps of: assigning a weight (col. 6, lines 15-16 'weighted algorithm') to each of one or more selected values of one or more installation parameters associated with a plurality of software products (col. 5, lines 37-40 'the planning tool could come as a standalone application which has knowledge of ... a particular set of applications'); determining a plurality of potential target systems on which the software product installation might be performed (col. 6, lines 55-59 'changing the installation from three machines to two machines'); identifying a routine to analyze each of the installation parameters (col. 5, lines 43-44 'performance calculations');

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programmatically interrogating each of the potential target systems for its status of each of the installation parameters, using the identified routines (col. 5, lines 45-48 'The planning tool senses the hardware capacity'); and using the assigned weights, in combination with the selected values and the status of each of the installation parameters (col. 6, lines 15-16 'weighted algorithm'), to compute a suitability assessment for each of the potential target systems (col. 6, lines 36-39 'the planning tool may indicate that performance would be "not acceptable"').

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. **Claims 8-10 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 5,761,380 to Lewis et al. (Lewis) in view of US 6,662,163 to Albayrak et al. (Albayrak).**

Regarding Claim 8: The rejection of claim 1 is incorporated; further Lewis does not disclose the assigned weights and selected values are specified using a structured markup language.

Albayrak teaches the use of XML documents (col. 8, lines 43-44 'XML-based documents') in an analogous art for the purpose of storing configuration data (col. 8, lines 43-44 'configuration data files are stored as XML-based documents').

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It would have been obvious to a person of ordinary skill in the art at the time of the invention to store the data regarding the selected values in an XML file as taught by Albayrak (col. 8, lines 43-44) because XML is a technology well recognized in the art for the purpose of holding data (col. 2, lines 13-18 'Means for representing and processing information are also becoming standard. In particular, the XML').

Regarding Claim 9: The rejection of claim 8 is incorporated; further, Lewis does not disclose the structured markup language is Extensible Markup Language ("XML") or a derivative thereof.

Albayrak teaches the use of XML documents (col. 8, lines 43-44 'XML-based documents') in an analogous art for the purpose of storing configuration data (col. 8, lines 43-44 'configuration data files are stored as XML-based documents').

It would have been obvious to a person of ordinary skill in the art at the time of the invention to store the data regarding the selected values in an XML file as taught by Albayrak (col. 8, lines 43-44) because XML is a technology well recognized in the art for the purpose of holding data (col. 2, lines 13-18 'Means for representing and processing information are also becoming standard. In particular, the XML').

Regarding Claim 10: The rejection of claim 1 is incorporated; further, Lewis does not disclose the assigned weights, the selected values, and the identifications of the routines are specified using a structured markup language.

Albayrak teaches the use of XML documents (col. 8, lines 43-44 'XML-based documents') in an analogous art for the purpose of storing configuration data (col. 8, lines 43-44 'configuration data files are stored as XML-based documents').

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It would have been obvious to a person of ordinary skill in the art at the time of the invention to store the data regarding the selected values in an XML file as taught by Albayrak (col. 8, lines 43-44) because XML is a technology well recognized in the art for the purpose of holding data (col. 2, lines 13-18 'Means for representing and processing information are also becoming standard. In particular, the XML').

Regarding Claim 17: The rejection of claim 12 is incorporated; further Lewis does not disclose the specified routines in the transmitted message are encoded using a structured markup language.

Albayrak teaches the use of XML documents (col. 8, lines 43-44 'XML-based documents') in an analogous art for the purpose of storing configuration data (col. 8, lines 43-44 'configuration data files are stored as XML-based documents').

It would have been obvious to a person of ordinary skill in the art at the time of the invention to pass messages in XML format as taught by Albayrak (col. 8, lines 43-44) because XML was a technology well recognized in the art for the purpose of processing data (col. 2, lines 13-18 'Means for representing and processing information are also becoming standard. In particular, the XML').

Regarding Claim 18: The rejection of claim 14 is incorporated; further Lewis does not disclose the status of each of the installation parameters in the response message is encoded using a structured markup language.

Albayrak teaches the use of XML documents (col. 8, lines 43-44 'XML-based documents') in an analogous art for the purpose of storing configuration data (col. 8, lines 43-44 'configuration data files are stored as XML-based documents').

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It would have been obvious to a person of ordinary skill in the art at the time of the invention to pass messages in XML format as taught by Albayrak (col. 8, lines 43-44) because XML was a technology well recognized in the art for the purpose of processing data (col. 2, lines 13-18 'Means for representing and processing information are also becoming standard. In particular, the XML').

Conclusion

9. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. US 6,154,128 to Wookey et al.; US 6,549,914 to Valys; US 6,651,246 to Archambault et al.; US 6,751,616 to Chan; US 6,789,252 to Burke et al.; US 6,817,016 to Wegman et al.; US 6,823,510 to Rajan et al.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason Mitchell whose telephone number is (571) 272-3728. The examiner can normally be reached on Monday-Thursday and alternate Fridays 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kakali Chaki can be reached on (571) 272-3719. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jason Mitchell
1/25/05

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